

REMARKS

Applicants have canceled claims 65-73 and added new claims 74-83. Claims 74-83 are re-written versions of canceled claims 65-73.

The Office Action mailed November 15, 2005 rejects claims 65-73 under 35 U.S.C. § 112, for having language the Patent Office deemed to be indefinite. New claims 74-83 are believed to be free from such language.

In particular, claim 74 (the new version of claim 65) lacks the phrase "such as current, past, or never" that was present and objected to in claim 65. Claim 75 lacks the phrases "such as concurrent fever, sweats, headache, and sore throat being part of a common flu" and "such as coming and going together in the same time pattern" that were present and objected to in claim 66. Claim 76 lacks the phrase "such as bowel symptoms or bone and joint symptoms" that was present and objected to in claim 67. Claim 78 lacks the phrase "such as physical symptoms, health conditions, emotional problems, or other issues" that was present and objected to in claim 69. Claim 79 does not mention an example of a patient at risk for coronary heart disease, as did claim 70.

Thus, the present claims are believed to overcome the indefiniteness rejections made against corresponding claims 65-73.

The Office Action also rejected claims 65-73 under 35 U.S.C. § 112 based on the assertion that those claims fail to comply with the written description requirement. This rejection, to the extent that it applies to pending claims 74-83, is respectfully traversed.

The Office Action seems to imply that the written description requirement is not satisfied unless language in the claims occurs verbatim in the specification (see page 3 of

the Office Action: “The following statements are not recited in the original specification.”). That, of course, is incorrect. There “is no *in haec verba* requirement” for written description. MPEP 2163(I)(B). (“*In haec verba*” means “in the same words.”) The requirement is only that “newly added claims must be supported in the specification through express, implicit, or inherent disclosure.” *Id.* Applicants demonstrate herein that the present claims are supported in the specification.

Claim 65 was alleged to lack written description on seven different grounds. Grounds 1 and 2 do not apply to claim 74. However, for the record, reserving detailed questions for positive groups is supported in the specification at least at page 2, lines 7-8; page 20, lines 2-5; and pages 43-44. Ground 3 (“degree of bother”) does not apply to claim 74; “magnitude of problems” is in claim 74 and is supported in the specification at least at page 45, lines 7-10 and page 63, lines 3-5. Ground 4 is directed to “rephrase subsequent, more detailed questions”; that limitation is supported at least at page 20, lines 14-16; page 44, line 18 et seq.; page 42, lines 19-22; and pages 80-81. Grounds 5 and 7 are directed to “configuration profile”; that limitation is supported at least at page 29, lines 11-18; page 31, lines 6-8; and pages 81-83. Ground 6 does not apply to claim 74.

Claim 66 also was rejected on seven grounds. Ground 1 is directed to “potential associations between symptoms”; that limitation is supported at least at page 43, line 21 to page 44, line 11; page 47, lines 3-7; and pages 55-60. Ground 2 does not apply to claim 75. Grounds 3 and 4 are directed to “index symptom”; that phrase is defined in the claim itself to mean “a most severe symptom in an association,” which in turn is supported at least at pages 55-60. Ground 5 does not apply to claim 75. Ground 6 is

directed to the “redundant characterization detail is skipped limitation”; that limitation is supported at least at page 43, lines 6-10; page 44, lines 15-16; page 56, lines 9-10; and page 59, lines 2-5. Ground 7 is directed to the “risk of frustrating the patient is reduced” limitation, which is supported at least at page 43, line 19; page 19, lines 15-17; and page 45, lines 5-7.

Claim 67 was rejected on three grounds. Ground 1 does not apply to claim 76. Ground 2 is directed to the “functional status” limitation, which is supported at least at page 21, lines 12-14; page 63, line 14; and page 64, lines 15-16. Ground 3 is directed to calculating separate scores for symptom groups; this limitation is supported at least at page 63.

Claim 68 was rejected on five grounds. Ground 1 is directed to “functional status,” which is addressed above. Ground 2 is directed to “generic domains”; this limitation is supported at least at page 21, lines 13-19; and page 63, lines 7-14. Grounds 3-5 do not apply to claim 77.

Claim 69 was rejected on six grounds. Grounds 1-3 do not apply to claim 78. Ground 4 is directed to “functional status,” addressed above. Ground 5 is directed to the “sequentially display” limitation, which is supported at least at pages 19-20. Ground 6 is directed to the “generic quality of life issues” limitation, which is supported at least at page 21, lines 13-19; page 55, lines 11-15; and page 63, lines 7-14. Claim 69 and claim 78 also are supported at least by FIGS. 3, 7A, and 7B.

Claim 70 was rejected on five grounds. Ground 1 is directed to the “patient willingness to change health behaviors” limitation, which is supported at least at page 8,

lines 16-19; page 26, lines 8-9; and page 74, line 9. Ground 2 is directed to the “patient perception of communication with a clinician” limitation, which is supported at least at page 6, lines 21-22. Ground 3 is directed to the “whether patients were heard and respected” limitation, which is supported at least at page 6, lines 21-22; and page 73, lines 19-20. Ground 4 is directed to the “patient observation about health care received” limitation, which is supported at least at page 22, lines 6-9; and page 74, lines 2-6. Ground 5 is directed to the “improvement data are presented to clinicians” limitation, which supported at least at page 2, lines 12-18; page 3, lines 1-4; page 26, line 14 to page 27, line 3; and page 73, lines 9-15. Claims 70 and 79 also are supported at least at page 26; page 72, lines 16-18; and FIG. 3.

Claim 71 was rejected on six grounds. Grounds 1 and 3-6 do not apply to claim 80. Ground 2 is directed to “different levels of severity,” which is supported at least at page 45, lines 7-10 and page 63, lines 3-5. Claim 80 does contain the limitation “severity score,” which is supported at least at page 54, lines 1-2 and page 63, lines 12-13. More generally, support for claim 80 (and for claim 83) may be found at pages 7, 12, 17, 21, 25, and 65.

Claim 72 was rejected on two grounds. Ground 1 does not apply to claim 81. Ground 2 applies to the entire body of claim 72 (which is the same in claim 81). The claim body is supported (as are all of the claims) by the knowledge of one skilled in the art, and is further supported at least at pages 41-42, and page 4, lines 1-2.

Claim 73 is rejected on one ground, which is directed to the “patient who agrees to participate in research.” But this is inherent in the concept of informed consent in the context of the discussion at pages 41-42 of the specification.

The Patent Office is respectfully reminded that support for claims need not be explicit – it may also be implicit or inherent. Also, the written description requirement only requires that there be sufficient written description to inform one skilled in the art that the applicant was in possession of the claimed invention as a whole at the time the application was filed. See MPEP 2163(II)(A)(3). Thus, the knowledge in prior art must be taken into account when determining whether the written description requirement has been satisfied.

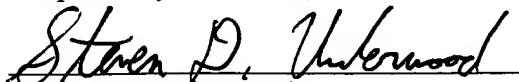
Moreover, the Examiner “has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims.” MPEP 2163(II)(A)(3)(b). The Office Action provides no such evidence or reasoning.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and the timely allowance of all pending claims.

No fees (other than the extension fee authorized above) are believed due with this Response. However, if any other fees are due, please charge such fee to Deposit Account 50-0310.

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Respectfully submitted,


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